

REMARKS

Claims 3-7 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out distinctive claims subject matter with Applicant regards as the invention. It is noted that the Examiner has substantially repeated verbatim the previous rejection of claims 1-5 based on the premise that it "the method fails to recite a specific method step regarding the detection or measuring of these conditions or physical parameters, which permit the determination of calculation of these thermodynamic hydrate formation conditions".

The premise behind a rejection under the second paragraph of 35 U.S.C. §112 is that the Applicants have failed to particularly point out distinctly claims subject matter which the Applicants regard as their invention. The Examiner refers to MPEP §2171 which states in part:

"[t]he inquiry during examination is patentability of the invention as Applicant regards it. If the claims do not particularly point out distinctly claim that which Applicants regard as their invention, the appropriate action by the Examiner is to reject the claims under 35 U.S.C. §112, second paragraph...if a rejection is based on 35 U.S.C. §112, second paragraph, the Examiner should further explain whether the rejection is based on indefiniteness or on the failure to explain what Applicants regard as their invention."

~~Applicants regard the subject matter of independent claims 6 and 7 to be of a~~
scope which they regard as their invention.

It is Applicants position that the Examiner's contention that certain additional limitations must be recited in the claims to render them definite is an undue limitation of the invention given that the issue is not patentability over the prior art and only whether the Applicants have particularly pointed out and distinctly claim the subject matter which they regard as their invention.

The Examiner is referred to MPEP §2172 "Subject Matter Which Applicants Regard as Their Invention" under "Focus for Examination" wherein it is stated in part "in other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which the Applicants regard as their invention" which is the position of the Applicants.

The Examiner is referred to §2172.01 "Unclaimed Essential Matter" which is the premise for the Examiner's rejection where it is stated:

"[a] claim which omits matter described to the essential to the invention as described in the specification or other statement of record may be rejected under 35 U.S.C. §112, first paragraph is not enabling which is not an issue in the present rejection which is premised upon indefiniteness."

There are no statements in Applicants' specification that the particular steps the Examiner deems to be necessary are admitted to be necessary to practice the invention.

The Examiner is referred to MPEP §2173.04 "Breadth Is Not Indefiniteness". As stated therein "[b]readth of a claim is not to be equated with indefiniteness" and further "[i]f the scope of a subject matter embraced by the claims is clear, and if the Applicants have not otherwise indicated they intend the invention to be of a scope different than that defining the claims, then claims comply with 35 U.S.C. §112, second paragraph". It is submitted that the authority of MPEP §2173.04, as quoted above, is directly in point and demonstrates that Examiner's rationale for rejecting the claims as being indefinite is legally erroneous.

Moreover the Examiner is referred to MPEP §2164.08(c) which states, consistent with the Examiner's admission "[a]lthough there is no pending rejection of the prior art" that "[l]imiting the Applicant to the preferred materials

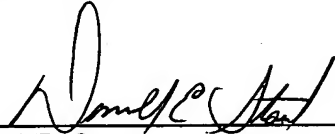
in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the use for arts" emphasis added.

In summary the Examiner has arbitrarily substituted a requirement of what he deems to be essential subject matter which has not been indicated or admitted by the Applicants to be critical or necessary in the Applicants' specification to practice of their invention. Given the absence of applicable prior art, it is submitted that Applicants have particularly pointed out in distinctive claimed the subject matter which they regard as their invention to define patentable subject with the degree of scope which is commensurate with the constitutional purpose of promoting progress in science and the useful arts.

Finally, the claims have been amended to correct typographical errors which do not change their scope. Allowance of the claims for the foregoing reasons is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 612.41243X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Donald E. Stout", is written over a horizontal line.

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Attachments